

REMARKS/ARGUMENTS

Claim 1 is pending in the present application. Claim 1 is amended. Support for the claim amendment can be found in the Specification on pages 21-23. No new matter is added. Reconsideration of the claims is respectfully requested.

Applicants have amended claim 1. Applicants do not concede that the subject matter encompassed by the earlier presented claim is not patentable over the art cited by the Examiner. Applicants amended claim 1 in this response solely to facilitate expeditious prosecution of this application. Applicants respectfully reserve the right to pursue the claims as presented prior to this amendment, and additional claims, in one or more continuing applications.

I. Examiner Interview

Applicants thank Examiner Shaw for the interview held on September 10, 2008 between the Applicants' representatives and the Examiner. Applicants proposed amended claim and the 103 rejection was discussed. Examiner acknowledged the amended claim which recited additional features. However, no agreement was reached regarding this rejection.

II. 35 U.S.C. § 103, Obviousness

II. A. Claim 1

The Examiner has rejected claim 1 under 35 U.S.C. § 103 as being unpatentable over *Beyda*. (US Pub No. 2003/0229670 A1)(*Beyda(A)*), in view of Marsot et al. (U.S. Patent No. 7,010,790 B2)(*Marsot(C)*), and Ayan (U.S. Patent No. 6,769,002 B2)(*Ayan(B)*). This rejection is respectfully traversed. Claim 1 has been amended as follows:

1. A method for filtering electronic mail messages on a client computer in a distributed computer network, the method comprising the computer implemented steps of:

determining whether an interrupt is associated with an electronic mail message, wherein the interrupt is a specific interrupt designation of the electronic mail message, and wherein the electronic mail message comprises an interrupt indicator attached to one of a header and a footer of the electronic mail message;

validating whether a sender of the electronic mail message is authorized to send the electronic mail message with the interrupt indicator;

responsive to a determination that the interrupt is associated with the electronic mail message and the sender is authorized to send the electronic mail message with the interrupt indicator, determining whether a desktop of the client computer is active;

responsive to determining that the desktop of the client computer is active, automatically displaying a content of the electronic mail message in a popup window, wherein the popup window comprises a reply button and an

action completed button, and wherein the popup window is displayed in a forefront position on the desktop of the client computer, and wherein the popup window remains in the forefront position until a recipient of the electronic mail message responds to the content of the electronic mail message by selecting one of the reply button and the action completed button

responsive to the recipient of the electronic mail message selecting one of the reply button and the action completed button, closing the popup window; responsive to determining that the sender is not authorized to send the electronic mail message with the interrupt indicator, delivering the electronic mail message to the recipient inbox; and

responsive to determining that the desktop of the client computer is inactive, delaying the display of the electronic mail message until the desktop becomes active.

The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *KSR Int'l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

A prima facie obviousness rejection cannot be stated against claim 1 because the combination of references, considered as a whole, does not teach or suggest all of the features in amended claim 1. Specifically, the cited references, individually and in combination, fails to teach or suggest the feature “responsive to determining that the desktop of the client computer is active, automatically displaying a content of the electronic mail message in a popup window, wherein the popup window comprises a reply button and an action completed button, and wherein the popup window is displayed in a forefront position on the desktop of the client computer, and wherein the popup window remains in the forefront position until the recipient of the electronic mail message responds to the content of the electronic mail message by selecting one of the reply button and the action completed button” as recited in claim 1 as amended.

In rejecting claim The Examiner cites to paragraph 0041 of *Beyda*:

[0041] Now referring to FIG. 4, another representative use of the system described above is illustrated. More specifically, in some embodiments, an application may be used to

provide a notification to a user via an instant message of a receipt of a communication transmitted via a differently delivery or communication channel (e.g., email, telephone). For example, the computer system 150 may operate the application 152, which is capable of registering with the instant message system 120 and sending (and possibly receiving) instant messages. The application 152 may receive an email message sent via an email messaging system 160 and use instant messaging to alert or otherwise notify the designated recipient of the email message of the receipt of the email message. The application 152 may be capable of identifying the intended recipient of the email message and sending an instant message to the designated recipient regarding the email message. The instant message may include information contained in or about the email message (e.g., identity of sender, time email message was received, attachments). The application 152 may register with the instant messaging system 120 before or after the email message is received. In some embodiments, the application 152 may be used by a specific person to manage, send, read, receive and display email messages.

Beyda, paragraph 0041.

Beyda teaches an application may be used to provide a notification to a user as an instant message. *Beyda* further teaches the application may also send an email message and send an instant message to the designated recipient of the email message, to notify the recipient that an email is forthcoming. However, nowhere does *Beyda* teach or suggest that the application determines whether the desktop is active before sending the instant message.

The Examiner asserts that *Marsot* makes up for the deficiencies of *Beyda* in teaching the interrupt indicator feature. The Examiner cites to the following:

The invention resolves these problems by implementing a method and modular device, each module having a specified role. Thus, a generation module produces and sends variable type multimedia messages on a telecommunications network in using a variety of communications protocols including HTTP, WAP (Wireless Application Protocol), SMTP (Simple Mail Transfer Protocol), SOAP (Simple Object Access Protocol), to mention only the most common protocols. A generation module of this kind is incapable of simulating the functioning of large number of customers. It is indeed possible to send out the multimedia message from an office computer, a pocket computer, a personal digital assistant and a mobile telephone to mention only the most common types of customers. The message produced comprises at least one body and a subject field. The generation module enters information into the subject field as a function of the type of multimedia message produced. Thus the subject field comprises a multimedia message identifier, a date for the production and sending of the multimedia message, an instruction code for a retrieval module, and/or a checksum of the multimedia message. The generation module also sends information to an analysis module on the multimedia messages that it produces and sends.

Marsot, col. 1, line 57 through col. 2, line 12.

Marsot teaches that a generation module produces and sends variable type multimedia messages through a network using a variety of protocols. The message produced comprises at least one body and a

subject field; the subject field comprises a multimedia identifier, a date, and an instruction code. However, *Marsot* fails to make up for the deficiencies of *Beyda* because *Marsot* does not teach or suggest that upon receipt of a message the desktop is determined to be active before the message is displayed. *Marsot* does not teach or suggest, in neither this section nor any other section, that the desktop is determined to be active before the message is displayed.

The Examiner also cites to *Ayan* as teaching features of the claimed invention. The Examiner cites to the following:

In accordance with one embodiment of the invention, an electronic mail communication system may be configured in accordance with a communication program comprising a hierarchy of participants, with each participant having a relative level of authority within the communication program for using system tools to create email messages. This may be employed, for example, to enable higher level participants to mandate the types of content and specific pieces of content that will be included in email messages sent on behalf of lower level affiliated participants within the hierarchy. In another example, this may be employed to enable a participant at a given level to generate system reports reflecting system information directly related to that participant's level, or to generate reports reflecting an aggregate of system information related to that participant's level and to participants at lower affiliated levels.

Ayan, col. 2, lines 14-29.

Ayan teaches an email communication system for creating messages and newsletters and for providing tools for performing related tasks such as content creation and email list management. The communication program allows for creating a hierarchy of participants that enables higher level participants to mandate the types of content and specific pieces of content that will be included in email messages to lower level affiliated participants. However, *Ayan* does not teach before an email message is opened by a participant who has received the email in accordance with the hierarchy, a determination is made whether the desktop is active before the email message is sent.

Neither, *Beyda*, *Marsot*, nor *Ayan* teaches or suggests “responsive to determining that the desktop of the client computer is active, automatically displaying a content of the electronic mail message in a popup window, wherein the popup window comprises a reply button and an action completed button, and wherein the popup window is displayed in a forefront position on the desktop of the client computer, and wherein the popup window remains in the forefront position until the recipient of the electronic mail message responds to the content of the electronic mail message by selecting one of the reply button and the action completed button,” as claimed in claim 1.

Moreover, for the reasons stated above, the combination of references fails to teach or suggest the feature “responsive to the recipient of the electronic mail message selecting on of the reply button and the action completed button, closing the popup window.” Neither *Beyda*, *Marsot*, nor *Ayan* teaches or suggest opening a popup window, such that in response to selecting a reply or action completed button the

window is automatically closed. These features are not taught in the sections cited by the Examiner, nor any other section in the cited references. Accordingly, because, the proposed combination of references, when considered as a whole, does not teach or suggest all the features of the claim 1, under the standards of *In re Royka*, the Examiner fails to state a *prima facie* obviousness rejection of claim 1. Therefore the rejection of claim 1 under 35 U.S.C 103 has been overcome.

II. B. No Sufficient Reason Exists Under KSR Int'l. To Combine the References

In combining references, an explicit analysis is required to combine or modify references. The Supreme Court has stated that it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).([R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness .). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *KSR Int'l v. Teleflex Inc.* 550 U.S.____, page 14 (2007). Conclusory statements are insufficient to support obviousness rejections. In particular, "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

In combining the cited references the Examiner stated:

It would be obvious to restrict the popup message based upon authority as per A [Beyda] and using metadata type parsing on subject field of message to implement the delivery of interrupt message as per C[Marsot] in the general art of message notification as per A[Beyda], B[Ayan] and C[Marsot]

Office Action of September 16, 2008, page 2.

However, this type of reasoning does not comport with the requirements of *KSR Int'l*. An express analysis has not been provided in the Examiner's reasons for combining the references. The statements made by the Examiner do not provide reasons as required in the Supreme Court's guidance on combining references in the *KSR* case. Instead, the Examiner has only provided conclusory statements that are recite some desired goal. These conclusions and desired goals have not been supported with any explicit analysis or articulated reasoning with some rationale underpinnings to support the conclusions or goals for combining the elements in these two references in the manner proposed by the Examiner. Further,

even if these conclusory statements or goals could be considered “reasons”, they do not have any articulated reasoning with some rational underpinning to support the Examiner’s assertion of obviousness.

II.C. No Sufficient Reason Exists Under KSR Int’l. To Combine the References Because Each Reference Represents a Complete Solution to the Problem That Each Solves

No proper reason exists to combine the references exists because both *Beyda*, *Marsot* and *Ayan* represent complete solutions to the problems each solves. As discussed above, *Beyda* teaches a method for enabling a notification, created by an application, to be sent to a user as an instant message. This This method facilitates instantly notifying a user of an event. The implementation of this method requires the application and the user be registered with an instant messaging system.

Marsot teaches generating multimedia messages to measure the performance of a system by reviewing how they travel through a telecom network. *Marsot* Each message is generated by a parameterizable module. Each message is generated with a different message identifier which is used by a filtering module. *Ayan* is directed to configuring a system in accordance with an electronic mail communication program participant hierarchy.

Each reference provides a complete solution to the problem that each reference represents. Therefore one of ordinary skill would see no benefit to combining the references. Consequently, there is not an apparent reason for one of ordinary skill in the art to combine the references in the manner suggested by the Examiner to reach the present invention in claim 1. Accordingly, no prima facie obviousness rejection can be stated against claim 1.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference(s) and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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